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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/759,698	01/12/2001	Steven Robert Mayle	MAY1023-012	2647

8698 7590 03/29/2002
STANDLEY & GILCREST LLP
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DUBLIN, OH 43017

EXAMINER

NGUYEN, CHI Q

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 03/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/759,698

Applicant(s)

MAYLE, STEVEN ROBERT

Examiner

Chi Q Nguyen

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 13-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 13-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Two Grouping Restrictions

Restriction to one of the following inventions is required under 35 U.S. 121:

I. Claims 1-12, drawn to apparatus of covering a protrusion on a roof, classified in class 52, subclass 60.

II. Claims 13-19, drawn to method of making a covering protrusion on a roof, classified in class 156, subclass 165.

2. Inventions I and II are related as process if either of the following can be shown:

(1) that the process as claimed can be used to make other and materially different product or

(2) that the product as claimed can be made by another and materially different process.

For instant case, the apparatus claims could be made by a method different than that of group II such as using a sheet of waterproof (e.g. elastic material) dimensioning a work piece to be applied thus cover around protruding surface of the roof and seal with cured adhesion.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purpose as indicated is proper.

4. During a telephonic conversation on 3/21/02 to request an oral election to the above restriction requirement, Applicant had elected group I (claims 1-12) apparatus of covering a roof with traverse.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 5-7, and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Lyons (US 4,603,517).

Lyons discloses a corner gap support comprising a base portion 44 having openings in between, a top portion 42 connecting to the base portion 44, a base flap portion 46 interposed between first and second of base portion, and extends from a bottom edge of top portion 42 (see figs. 3-4).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 4, 9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lyons (US 4,603,517) in view of Gentry (US 4,625,469).

Lyons discloses a corner gap support comprising a base portion 44 having openings in between, a tip portion 42 connecting to the base portion 44, a base flap portion 46 interposed between first and second of base portion and extends from a bottom edge of top portion 42.

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Lyons does not disclose expressly the base and top portions are welded, having a cone shaped. Gentry teaches replacement flat roof insulation cover having a flexible membrane or boot including a base portion 60 and top portion 58 and having a cone-shaped (see figs. 9a, 9b). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify and combine Lyons' invention with Gentry's teaching for a cone-shaped boot. The motivation for doing so would have been to provide more convenience for installers when they need for covering pipes or other applications with have the similar shape requirement.

Lyons and Gentry disclose the structural elements for covering protrusion a roof except for the base and top portions are welded together, examiner considers it is a method of forming a device and not germane to the issue of patentability of the device itself.

Therefore, this limitation has been given patentable weight.

Conclusion

5. Any inquiry concerning this communication should be directed to Chi Q. Nguyen whose telephone number is (703) 605-1224, Monday-Thursday (7:00-5:00), Fridays off or examiner's supervisor Carl D. Friedman at (703) 308-0839.

CQN 3/21/02



Carl D. Friedman
Supervisory Patent Examiner
Group 3600